

Remarks

Claims 1-35 were pending in the subject application. Due to a Restriction Requirement, claims 23-35 have been withdrawn. By this Amendment, the applicants have amended claims 1, 3, and 19. No new matter has been added by these amendments. Support for these amendments can be found throughout the original specification and claims (see, for example, page 3, lines 18 and 31-32). Accordingly, claims 1-22 are now before the Examiner for consideration.

The amendments to the claims have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution. The amendments should not be taken to indicate the applicants' agreement with, or acquiescence to, the rejection of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

Initially, claim 19 has been objected to due to formalities. The applicants thank the Examiner for carefully reviewing the claims. By this Amendment, the applicants have amended claim 19 to improve the clarity of the claim language, as suggested by the Examiner. Accordingly, reconsideration and withdrawal of the objection to claim 19 is respectfully requested.

Claims 1-22 have been rejected under 35 U.S.C. §101 for encompassing two different statutory classes of invention. The applicants respectfully traverse because claims 1-22 are directed only to a method.

The Office Action states that claim 1 is drawn to both a method and a device and, therefore, neither a method nor a device. The applicants respectfully point out that claim 1 recites “a method for monitoring cells in a microfluidic device,” wherein the monitoring is under conditions such that attachment of cells to the surface of the chamber is inhibited. The recitation of features of the microfluidic device merely serves to describe the device that is used while practicing the claimed method. It is not uncommon for a method claim to include a description, as in the present case, of the features of a device or composition used in the method. Thus, the claims are drawn to a single statutory class of invention, specifically a method.

While the applicants submit that the claims as previously presented were drawn to a method, in an effort to expedite prosecution, claim 1 has been amended to more clearly recite steps for

performing the method. Specifically, the method includes the steps of: feeding cells into a microfluidic device through one or more microfluidic channels; and monitoring the cells under conditions such that attachment of the cells to the surface of the chamber is inhibited. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §101 is respectfully requested.

Claims 1-22 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The applicants respectfully traverse this ground for rejection because the claimed subject matter is clearly defined.

As discussed above with respect to the rejection under 35 U.S.C. §101, the claims as previously presented were drawn to a method. However, in an effort to expedite prosecution, claim 1 has been amended to more clearly recite steps for performing the method.

Regarding the rejection of claim 3, the applicants once again thank the Examiner for carefully reviewing the claims. Claim 3 has been amended to clarify that the gas-permeable material is permeable to at least one gas selected from the group consisting of CO₂, NH₃, and O₂.

The claims particularly point out and distinctly claim the subject matter regarded as the invention. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claims 1-5, 7-11, 13-16 and 19-22 have been rejected under 35 U.S.C. §102(e) as being anticipated by Jensen *et al.* (U.S. Patent Application No. 2004/0077075). The applicants respectfully traverse.

Submitted herewith is an unsigned Declaration under 37 CFR §1.131 showing that the co-inventors of the present application conceived of the subject matter of the invention prior to May 1, 2002, and diligently worked on the invention at least until the filing date of the United Kingdom application from which the subject application claims priority. The applicants will provide the executed Declaration to the Examiner under separate cover. Since the filing date of the earliest application from which Jensen *et al.* claims priority is May 1, 2002, the Jensen reference is not prior art. Thus, while the applicants do not agree that Jensen *et al.* disclose each and every aspect of the claimed invention, because the Jensen *et al.* reference is not available as prior art, the rejection under

35 U.S.C. §102(e) is moot. Accordingly, reconsideration and withdrawal of the anticipation rejection based on Jensen *et al.* is respectfully requested.

Claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Jensen *et al.* as applied to claims 1-5, 7-11, 13-16, and 19-22 above, and further in view of Wada *et al.* (WO 99/67639). Claims 12 and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jensen *et al.* as applied to claims 1-5, 7-11, 13-16, and 19-22 above, and further in view of Lowe *et al.* (U.S. Patent No. 5,989,923). Claims 17 and 18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jensen *et al.* as applied to claims 1-5, 7-11, 13-16, and 19-22 above, and further in view of Walker *et al.* (U.S. Patent No. 5,474,774) and Qian *et al.* (Analytical Chemistry, 2002). The applicants traverse each of these grounds for rejection.

While the applicants do not agree that the claimed invention is rendered obvious by any of the combinations of references cited under 35 U.S.C. §103, the applicants respectfully point out that each of these rejections is based on Jensen *et al.* as the primary reference. As noted above with respect to the rejection under 35 U.S.C. §102(e), the Jensen reference is not prior art. None of the secondary references (Wada *et al.*, Lowe *et al.*, Walker *et al.*, or Qian *et al.*) disclose or even suggest the novel and advantageous methods of the claimed invention. Accordingly, reconsideration and withdrawal of each of the rejections under 35 U.S.C. §103 is respectfully requested.

Claims 1, 3, 9-12, 14, 16, 19, and 20 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 8, and 14 of copending Application No. 10/520,331. Upon indication of allowance of the copending ‘331 application, the applicants will file a Terminal Disclaimer at that time if it is necessary.

In view of the foregoing remarks and the amendments above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



David R. Saliwanchik
Patent Attorney
Registration No. 31,794
Phone: 352-375-8100
Fax No.: 352-372-5800
Address: P.O. Box 142950
Gainesville, FL 32614-2950

DRS/la

Attachments: Declaration under 37 CFR §1.131
Exhibit A – presentation slides